UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,669	12/11/2003	Yon Hardisty	51671/DMC/F419	6278

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EXAMINER
ENATSKY, AARON L

ART UNIT	PAPER NUMBER
3713	

DATE MAILED: 07/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on _12/11/03_ .

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) _1-9,11-15,17-21,23 and 24_ is/are pending in the application.

  4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) _1-9,11-15,17-21,23 and 24_ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on _11 December 2003_ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

  Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

  If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

  a) ☐ All b) ☐ Some * c) ☐ None of:

    1. ☐ Certified copies of the priority documents have been received.

    2. ☐ Certified copies of the priority documents have been received in Application No. _____ .

    3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage
      application from the International Bureau (PCT Rule 17.2(a)).

  * See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

  a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _12/11/03_ .

4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 9 recites the limitation "the solicitation to the player" in line 2 of claim 9. There is insufficient antecedent basis for this limitation in the claim. There is no prior mention of any limitation that can be construed as a prior solicitation.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 3-4, 9, and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over First Internet Backgammon Server 1992 (FIBS) in view of US Patent No. 6,449,344 to Goldfinger et al. ("Goldfinger").

In re claim 1, FIBS is an online multi-player game that teaches a player selecting a game to play where in the game is a backgammon game, a player querying a presence server for

available opponents and presenting a list of opponents (Pg. 2, Player status), providing status of

users (Pg. 2, Player status), selecting an opponent to play against wherein the message is a match

invite (Pg. 2, Player status), and beginning a game when a player has accepted which is inherent.

FIBS does not explicitly teach providing the IP address of the other user, or teach a user defined

list of user names. However, in regard to the IP address feature, it would have been obvious to

one of ordinary skill when creating any network multi-user communication system to provide the

IP address of other users to communicate with. Without the IP address users would not be able to

communicate with one another. Furthermore, Goldfinger teaches a network communication

program that provides a user with notification and status of user-defined lists of other network

participants as well as the sharing of IP address information of other network participants (2:1-

47). One would be motivated to modify FIBS to include the user status from a user definable list

as Goldfinger teaches this feature allows predefined users to be located quickly and efficiently

(2:8-18) saving a game player extra effort in sorting out on-line acquaintances. Therefore, it

would have been obvious to one of ordinary skill in the art at the time the invention was made to

modify FIBS with the user defined lists taught by Goldfinger to reduce the burden on a user to

find desired players in the on-line game.

In re claim 3, FIBS teaches configuring a game to work with instant messaging software,

wherein FIBS describes the game working with a chat program (Pg. 2, Chatting). Downloading

the FIBS software from a server is also provided (Pg. 3, Brief history of FIBS).

In re claim 4, FIBS teaches polling a receiving a list of available players (Pg. 2, Player

status), inviting/soliciting a player to join a game (Pg. 2, Player status), and a response by a

player through a chat program (Pg. 2, Chatting).

In re claims 9 and 12, FIBS teaches providing game software to a player on-line (Pg. 2, Username and password).

In re claim 11, FIBS teaches communication through the Internet using the telnet command as the underlying protocol of FIBS (Pg. 2, Player status; Pg. 3, Brief history of FIBS).

Claims 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over FIBS in view of Sparks, II '479 (Sparks). FIBS teaches the limitations as discussed above, but does not teach of a plurality of games for a user to select from. Sparks teaches an online gaming system for multiple players wherein players are given a choice as to which game to select (Abstract). FIBS and Sparks are related with respect to both providing online games where users can meet other players to compete against. As FIBS is an old, established, and working online gaming system, one would be motivated to modify FIBS to include a plurality of other games as taught by Sparks for increased entertainment value where one would not get bored with only a single game offering. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify FIBS to include a plurality of user selectable games as taught by Sparks to increase the entertainment value, thus increase game server usage.

Claims 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over FIBS in view of Goldfinger as applied to claims 1, 3-4, 9, and 11-12 above, and further in view of Ad potential driving messaging war (AD). FIBS in view of Goldfinger teaches the limitations as discussed above, but does not teach using an advertising bar with the game. AD teaches that advertisements are common and well-known features in real-time chatting software such as AOL and MSN instant messengers (IM) (Pg. 1). AD also teaches that advertisements featured on IM software drive users back to other sites, which means the ads are hyperlinked/hotlinked (Pg. 1).

Lastly as users are targeted for specific advertisements, a tracking mechanism exists for reporting

displayed ads (Pg. 1). FIBS in view of Goldfinger and AD are related in that both teach real-time

communication over a network system. One would be motivated to modify FIBS in view of

Goldfinger to include advertisement displays as taught by AD so that the game is a revenue

generator (AD, Pg. 1) to defray the costs of running the game server (FIBS, Pg. 4). Therefore, it

would have been obvious to one of ordinary skill in the art at the time the invention was made to

modify FIBS in view of Goldfinger to include advertisements with the game and chat software,

to help defray operating costs. In further regard to ad generators/server, it is old and well known

that servers track ads displayed, user "click through" leading from an ad to the advertiser's

intended site. Lacking data on how many ads were server to users and how many users accessed

the ads, ad companies would not be able to bill companies utilizing their Internet ad service.

Claims 13-15, 17-21, and 23-24 are rejected under 35 U.S.C. 103(a) as being

unpatentable over FIBS in view of Ad potential driving messaging war (AD).

In re claim 13, FIBS teaches the limitations as discussed above, but does not teach using

an advertising bar with the game. AD teaches that advertisements are common and well-known

features in real-time chatting software such as AOL and MSN instant messengers (IM) (Pg. 1).

AD also teaches that advertisements featured on IM software drive users back to other sites,

which means the ads are hyperlinked/hotlinked (Pg. 1). Lastly as users are targeted for specific

advertisements, a tracking mechanism exists for reporting displayed ads (Pg. 1). FIBS and AD

are related in that both teach real-time communication over a network system. One would be

motivated to modify FIBS to include advertisement displays as taught by AD so that the game is

a revenue generator (AD, Pg. 1) to defray the costs of running the game server (FIBS, Pg. 4).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention

was made to modify FIBS to include advertisements with the game and chat software, to help

defray operating costs. In further regard to ad generators/server, it is old and well known that

servers track ads displayed, user "click through" leading from an ad to the advertiser's intended

site. Lacking data on how many ads were server to users and how many users accessed the ads,

ad companies would not be able to bill companies utilizing their Internet ad service.

In re claim 14, FIBS teaches generating an error message when encountering

communication/connection problems (Pg. 5).

In re claim 15, FIBS teaches individual games of online backgammon.

In re claim 17, FIBS teaches determining possible opponents, which becomes a selectable

list of opponents (Pg. 2, Player status).

In re claim 18, FIBS teaches contacting a user to play a game (Pg. 2, Player status).

In re claim 19, FIBS teaches providing instruction for obtaining game software online

(Pg. 2, Username and password), and game software providing instructions (Pg. 6). Furthermore,

as FIBS in view of AD provides instant messaging, a first user could communicate any

information to a second user, which could includes instructions on how to obtain and play the

game.

In re claim 20, FIBS in view of AD teach providing advertisements during software

usage as discussed above in claim 13.

In re claim 21, FIBS teaches communication through the Internet using the telnet

command as the underlying protocol of FIBS (Pg. 2, Player status; Pg. 3, Brief history of FIBS),

which is an Internet navigator.

In re claim 23, FIBS teaches as above, the remote communication link is the Internet.

In re claims 24, FIBS in view of AD teach the advertisement system as disclosed in claim 13.

Citation of Pertinent Prior Art

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US 5,793,365 to Tang et al., US 5,960,173 to Tang et al., US 5,880,731 to Liles et al., and US 5,848,134 to Sekiguchi et al. all teach network communication systems that show what tasks other are currently working on, along with visual and audible communication.
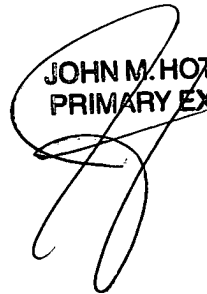
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron L Enatsky whose telephone number is 703-305-3525. The examiner can normally be reached on 8-6 M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 703-308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ALE

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PRIMARY EXAMINER